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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/215,058

Applicant(s)

HOFFMAN ET AL.

Examiner

James W Myhre

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[Signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on June 14, 2004 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission (After-Final Amendment) filed on April 26, 2004 has been entered.

Response to Amendment

2. The amendment filed on April 26, 2004 under 37 CFR 1.116 has been considered but is ineffective to overcome the Houvener et al (6,070,141) and Daugman (5,291,560) references. The amendment added Claims 29-31 and amended Claims 3-5, 10, and 23. The currently pending claims considered below are Claims 1-12 and 23-31.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.

A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The Applicant indicated on page 6 of the amendment filed on April 26, 2004, that "a terminal disclaimer will be filed once the claims are allowed over prior art". Therefore, the Examiner maintains the double-patenting rejection of Claims 1-12, 23, and 27 as indicated below.

Claims 1-12, 23, and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 9-1, 20, 21, 24-26, 28, and 29 of U.S. Patent No. 5,870,723 in view of claim 1 of U.S. Patent 6,269,348.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

common subject matter, as follows: the patent is claiming a method for tokenless authorization of commercial transactions using biometric data by comparing the user's current biometric data with previously stored biometric sample data. There are only two differences between the patented claim 1 and the present claim 1. First, the patent includes the feature of the seller registering not only an account number as in the application, but also a seller identification code. However, in claim 7 of the patent the seller identification code is the same as the seller's account number, therefore eliminating this difference between the claims. Second, the patent includes the feature of the buyer registers not only an account number and biometric sample as in the application, but also a personal identification number (PIN). The Examiner notes that the exclusion of the requirement to register a PIN would have been an obvious variation of the patent. Indeed, in Claim 1 of Patent No. 6,269,348, which claims priority from the above patent, the Applicant only requires the buyer to enter a biometric sample and an account number.

The other dependent claims listed above are substantially word-for-word duplicates of the dependent claims of the patent. The Examiner notes, however, that the parties involved in the transactions are identified using different terminology. In the patent, the parties are identified as the buyer and the seller. In the instant application, they are identified as the user and the seller. Since both sets of terms refer to the two parties involved in a transaction, the Examiner finds no patentable distinction by this use of alternative terminology. Likewise, the amendment filed on April 28, 2003 changed the "the user's personal authentication information" in Claim 1 to "the user's personal

identification information". However, this merely changed the terminology used to describe the same biometric sample being received from the user; and, thus, no patentable distinction exists between this alternative terminology.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 and 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houvenner et al (6,070,141) in view of Daugman (5,291,560) .

Claims 1, 2, 23, 24, 27, 29, and 30: Houvenner discloses a method for authorizing transactions using biometric identification, comprising:

- a. Registering the user's (customer's) biometric and account data (col 11, lines 33-37);
- b. Transmitting at least a biometric sample to a remote authentication system (col 7, line 45 - col 8, line 6);

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c. Comparing the transmitted biometric data with the stored registered biometric data to verify the identity of the customer (col 9, lines 16-21 and col 10, lines 8-15);

d. Transferring the payment between the customer's account and the merchant's account (or another of the user's accounts, e.g. electronic funds transfer from checking account to savings account) once it has been determined that the customer's account has sufficient funds (within its pre-approval credit limit)(col 7, line 45 - col 8, line 6); and

e. Presenting the results to the customer, merchant, or both (optional)(col 8, lines 3-6).

Houvenner discloses that a first of at least two identification units is input to the system by the customer ("person to be identified") at the point of sale, then transmitted to the database, which uses the first identification unit to locate a stored second identification information unit that is mapped to the received first identification information unit. Houvenner also discloses that the first identification information unit is any form of identification such as a driver's license number, a social security number or the like (col 9, lines 36-39) and that the second identification information unit is preferably biometric data pertaining to the customer. The system will then compare the stored biometric data with a biometric data sample supplied by the customer at the POS. Since the account number and the biometric data are linked within the database it would have been obvious to one having ordinary skill in the art at the time the invention was made once the identity of the customer has been verified that in order to

approve the transaction needs to be approved as discussed by Houvener. This approval in Houvener takes place through the normal credit card or banking approval channels using the account number that is linked to the identified individual. As Houvener claims in Claim 21, either of the identification information units could comprise a biometric identifier; thus, implying that the first identification information unit above could be the biometric identifier, not the account number. Thus, the biometric identifier could be used as the input to find the other part of the linked data, the account number. Moreover, the use of biometric data by Houvener to actually identify the individual (and, thus, his account) eliminates the need to use the account number to identify the individual, especially when combined with Daugman (see below).

While Houvener discloses comparing the customer's current biometric data with the stored biometric data to verify the identity of the customer (i.e. a one-to-one comparison) and that the database contains identification information about a plurality of persons (col 11, lines 33-38), it is not explicitly disclosed that the current biometric data is being compared to biometric samples from the plurality of customers in the database (i.e. a one-to-many) to determine the identity of the current customer. Daugman discloses a similar method for using biometric data (iris codes) to identify individuals in which the comparison may be between "two iris codes, as well as exhaustive searches through large databases of stored iris codes" and "could exhaustively compare a 'presenting' iris code against a population of 80 million previously stored iris codes within one second, to establish reliably whether the individual is any one of those persons" (col 18, lines 1-9). Therefore, it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to compare the current biometric data collected by Houvenner against the plurality of stored biometric data to identify the customer and, since Houvenner has linked the customer's account and biometric data, the customer's account number. One would have been motivated to compare the current biometric data to a plurality of stored biometric data in order to automatically and unobtrusively identify the customer without the need for the customer to present any kind of token, PIN number, signature, or the like automatically as discussed by Daugman (col 1, lines 52-55).

While Houvenner discloses using this biometric identification system for electronic transactions and banking functions to include transferring funds between accounts and explicitly discloses that the store clerk will be positively identified by the use of a smart card and PIN so that "the system can recreate a transaction and identify not only the person initiating the transaction but the clerk who was responsible for positively identifying the individual initiated the transaction" (col 11, lines 6-9), it is not explicitly disclosed that the merchant's account is going to be pre-registered with the system, nor that the merchant proposes a transaction offer to the customer. The Examiner notes that it is common to pre-register merchants and their account numbers with commerce systems for a variety of reasons. For example, pre-registering merchants provides a higher level of assurance to the customer that the merchant is an "approved" merchant that can be trusted to provide the goods/services. Pre-registering merchants also enabled the system to charge a pre-negotiated transaction fee to the merchant, such as is common with credit card transactions. By pre-registering, merchants are also able to

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complete transactions without having to transmit their account number over unsecure lines (e.g. the Internet) each time. For these and other well known benefits, it would have been obvious to one having ordinary skill in the art at the time the invention was made to register the merchant and to include at least one of the merchant's financial account number. One would have been motivated to include such a registration step for the merchants in the Houvener invention in view of the reasons above and Houvener's discussion of the importance of data protection on the Internet and processing the credit card transaction.

The Examiner notes that the definition of the merchant's transaction offer in Claim 1, wherein "the proposed commercial transaction comprising price information", reads on a catalogue, an advertisement, sales flyer, or verbal price quote by the merchant. Since almost all customers (except, possibly, extremely rich customers) would want to know the price of the goods/services before purchasing the goods/services, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the merchant to present the price of the goods/services to the customer. One would have been motivated to present the price to the customer in order to allow the customer to make a better business decision on the quality of the offer.

Claims 3-6 and 31: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claims 28 and 29 above, neither reference explicitly discloses using an account code to select an account, assigning a name to the account code, nor displaying a list of the accounts to the customer upon

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successful identification. Official Notice is taken that it is old and well known within the banking arts to display a list of accounts to a user (such as when operating an ATM terminal) and to identify the accounts using account codes and account names. For example, when a customer logs onto an ATM terminal and selects the type of desired transaction, the terminal will display a list of pertinent accounts and ask the customer to select one or more (depending upon the type of transaction). The list of accounts do not normally show the entire account number, which may be quite extensive in length, but rather the list consists of an account code (e.g. A, B, C, and D) and an associated account name (e.g. checking, savings, Christmas Club, money market). The customer normally selects the desired account by pressing the keyboard button indicated by the account code. A similar system is used to allow a customer to select the desired account when completing a transaction at a merchant's facility, such as a travel agency. If the customer has several travel accounts (e.g. business, executive, and personal), the system will display the list of the customer and allow the customer to enter the account code for the desired travel account. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display a list of accounts to Houvenier customer using account codes and account names and to allow the customer to select the desired account. One would have been motivated to display and use such a list in order to eliminate the need for the customer to remember the lengthy account numbers of each account, thus facilitating a more expeditious selection of the desired account and decreasing the opportunity for erroneous (undesired) selections.

Claim 7: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 1 above, but neither reference explicitly discloses creating a credit authorization draft. The Examiner takes Official Notice that credit authorization drafts as disclosed by Claim 7 were well known within the business arts and have been used extensively in business-to-business transactions to allow transactions to be completed, for example, without the need to pre-approve a transaction in which the final price may not be known ahead of time (e.g. repair of an office machine). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create a credit authorization draft in the Houvener reference. One would have been motivated to include the creation of a credit authorization draft in the Houvener reference in order to facilitate business-to-business transactions without overburdening the two accounting departments.

Claim 8: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 2 above, and Houvener further discloses the data being communicated between remote computer systems to determine resources and/or construct the credit authorization draft (col 7, line 45 - col 8, line 6).

Claim 9: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 1 above. While Houvener discloses including and storing the transaction data as a transaction record, it is not explicitly disclosed that the transaction data contains one or more of a list of goods/services, a seller name, a date and time, a location, or an invoice number. The Examiner notes that these are well known elements usually contained in transaction data files. Therefore, it would have

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been obvious to one having ordinary skill in the art at the time the invention was made to include one or more of these elements in the Houvener transaction data. One would have been motivated to include these features in order to facilitate delivery of the purchased goods/services and to better identify the transaction for accounting processing by all parties concerned, especially when attempting to "recreate a transaction" as discussed by Houvener (col 11, lines 4-9).

Claim 10: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 28 above, but neither reference explicitly discloses that the customer can receive cash back during the transaction. The Examiner takes Official Notice that cash back transactions were extremely well known throughout society at the time the invention was made and have been the major means for many people to maintain their supply of cash-on-hand for small purchases. For support of this notice, the Examiner is forwarding a patent (Patent Re 30,821) issued to Goldman in 1981 which extensively discusses cash back transactions at a point of sale terminal in which the system uses the symbol "CB" to indicate a cash back transaction or the signal "NC" to indicate a no-cash transaction. (col 8, lines 32-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the customer in Houvener to receive cash back during a transaction by entering an amount that exceeds the amount of the goods/services being purchased. One would have been motivated to allow a cash back transaction in order to increase customer satisfaction and goodwill and to allow the customer to have the cash to "tip"

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the merchant representative for exceptional service, provide change for parking meters, etc.

Claim 11: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 1 above. Houvener further discloses checking incoming registration biometric samples against previously stored biometric samples to prevent duplicate registration of individuals, either inadvertently or for fraudulent purposes (col 6, lines 52-67 and col 7, lines 38-42).

Claim 12: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 1 above. Houvener further discloses the type of biometric data being used consisting of one or more of "fingerprints, retinal images, or the like" (col 9, lines 16-20).

Claims 25 and 26: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 1 above. Houvener further discloses that the merchant will be identified by comparing stored identification data with identification data received over the remote connection. As an example, Houvener suggests the use of "commonly available caller ID technology to ensure that the request for data has originated from an authorized telephone line" (col 6, lines 20-31). Since Houvener also discloses that the system could be run not only through telephone network (hence, the caller ID example), but also through a wide area network, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use other known technology for verifying the sending unit in Houvener, to include network address comparison, hardware identification number comparison, etc.

One would have been motivated to use the hardware identification code in the identification comparison in view of its uniqueness, since manufacturers do not give the same hardware identification number to two items.

Claim 28: Houvener and Daugman disclose a method for authorizing transactions using biometric identification as in Claim 1 above, and Houvener further discloses adding the customer's current biometric data to the transaction offer data upon acceptance of the transaction by the customer (col 7, line 45 – col 8, line 6).

Response to Arguments

6. Applicant's arguments filed December 12, 2003 have been fully considered but they are not persuasive.

The Applicant argues in reference to Claim 1 that Houvener discusses a two-step process for verifying the identity of an individual for authorization of a transaction whereas the present invention uses a one-step process (page 6). The Applicant further argues that Daugman, while disclosing a one-step process for identifying an individual, does not discuss using a single-step process to identify a user for authorization of a transaction (page 7). First, the Examiner notes that both references use biometric data to identify an individual and, thus, are analogous art. Furthermore, while the purpose for identifying the individual such as for authorizing a transaction, for allowing access to a restricted area, for activating an electronic device, or for any other situation requiring the individual be reliably identified does not affect the process in which the identification takes place, Daugman explicitly discloses the reason for requiring such reliable

identification of the individual is that "human activities and transaction have proliferated in which rapid and reliable personal identification is required. Examples include passport control, computer login control, bank automatic teller machine and *other transaction authorizations*, premises access control, and security systems generally" (emphasis added)(col 1, lines 10-17). Thus, Daugman does discuss using his one-step process for identifying an individual for authorization of a transaction.

As for the two-step process disclosed by Houvener, the Examiner notes that the first step identifies the customer (and the account), and the second step verifies the identity of the customer. As discussed in the rejection above, Houvener discloses that the biometric data could be used as the first identification unit (used in the first "identification" step) or as the second identification unit (used in the "verification" second step). In an embodiment where the biometric data is the first identification unit, Houvener would receive and transmit the customer's biometric data to the remote database site, which would then correlate the received biometric data with the stored biometric data in the database to determine not only the identity of the customer, but the associated account of the customer as discussed in the rejection above. Daugman performs similar steps using biometric data about the customer's iris to identify the customer.

The Applicant also argues in reference to Claim 10 that cash-back transactions were not known prior to the present application's filing date in 1998 (page 8). The terminology in the rejection has been changed to note the fact that cash-back transactions were known at least as far back as 1998. The Examiner has also cited a

reference published in 1981 (Goldman) which supports the Official Notice by showing that cash back transactions were known at least by 1965, the filing date of the reference, which is over 30 years before the Applicant's filing date.

Finally, the Applicant argues in reference to Claim 11, that "Houvener does not teach or suggest that *any* re-registration be recognized" (page 9), but only shows that "a particular form of re-registration might be suspect." The Examiner notes that the claim includes the steps of comparing a newly registered biometric sample against previously stored biometric samples to determine if the applicant has previously registered. As the Applicant notes, this is exactly what steps Houvener also performs to determine if the applicant has previously registered. Whether the system is performing this comparison to prevent an applicant from registering more than once (present application) or for preventing the applicant from registering more than a predetermined number of times (Houvener) is the desired utility of the system, but does not change the steps performed. Furthermore, the system in Houvener could set the predetermined number to any number, including 1, which would then prevent an applicant from registering more than once, as in the present application.

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE**

FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

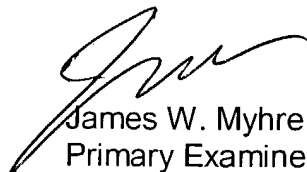
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
July 19, 2004


James W. Myhre
Primary Examiner
Art Unit 3622